

Appl. No. 10/656,021
Amdt. dated January 17, 2006
Reply to final Office action of October 28, 2005

REMARKS/ARGUMENTS

Applicant has received the final Office action dated October 28, 2005, in which the Examiner: 1) provisionally rejected claims 2, 4, 5 and (17-19 for the record only) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending Application No. 10/351,188 (now U.S. Pat. No. 6,974,661, hereinafter "Gore"); 2) provisionally rejected claim 3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Gore in view of Azuma (U.S. Pat. No. 6,815,679, hereinafter "Azuma"); 3) provisionally rejected claim 3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Gore in view of Jones et al. (U.S. Pat. No. 6,682,810, hereinafter "Jones"); and 4) provisionally rejected claims 2, 4, 5 and (17-19 for the record) under 35 U.S.C. § 102(e) as being anticipated by Gore.

With this Response, Applicant has amended claims 17 and canceled claims 6-16.

I. NON-STATUTORY DOUBLE PATENTING

The Examiner has rejected claims 2, 4-5, and 17-19 for obviousness type double patenting over copending Application Serial No. 10/351,188 ("the '188 application"). The '188 application is commonly owned with the instant application. In view of the fact that the '188 application has since issued as U.S. Patent No. 6,974,661, Applicant submits herewith a Terminal Disclaimer over that patent.

The Examiner also provisionally rejected claim 3 based on obviousness-type double patenting over the '188 application combined with the '679 patent to Azuma and over the '188 application combined with U.S. Patent No. 6,682,810 to Jones. As set out in the preceding paragraph, a Terminal Disclaimer has been submitted, which obviates these rejections.

II. § 102(E) REJECTION OVER THE '188 APPLICATION

The Examiner has provisionally rejected claims 2, 4-5, and 17-19 under 35 U.S.C. § 102(e) as being anticipated by the '188 application. Applicant has amended claim 17 to include the recitation previously added to claim 2, namely

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that the absorbing means comprises "a compound selected from the group consisting of compounds comprising a phthalocyanine chromophore and compounds comprising a naphthalocyanine chromophore." As set out in the *Response to Office Action dated January 13, 2005*, the differences in claim scope between the present application and the '188 application (now the '661 patent), preclude a Statutory Double Patenting Rejection. As set out hereinabove, Applicant has overcome the obviousness-type double patenting rejection by filing a *Terminal Disclaimer*. The sole remaining grounds for rejection over the '188 application is under § 102(e).

With the *Response to Office Action dated May 6, 2005*, Applicant submitted a *Declaration under Rule 1.132*, which included a statement that "Any feature or aspect of the presently claimed invention that is disclosed but not claimed in copending application Serial No. 10/351,188 was derived from the inventor of the present application." Applicant respectfully submits that this assertion conforms to the requirements of the Rule 1.132 as described in MPEP 716.10, a copy of which is appended hereto. Specifically, MPEP 761.10 reads, in relevant part:

[I]t is incumbent upon the inventors named in the application, in response to . . . a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant. (emphasis added)

Thus, the previously submitted *Declaration under Rule 1.132*, provided precisely the required assertions and is sufficient to overcome the rejection under § 102(e), particularly in view of the present amendment of claim 17. For this reason, Applicant respectfully requests withdrawal of this rejection and allowance of these claims.

It is believed that the present arguments and submissions address each of the outstanding issues. If the Examiner feels that the foregoing do not fully address and overcome the rejection under § 102(e), he is respectfully requested to telephone the undersigned to discuss the issues.

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III. CONCLUSION

Applicant believes that the present paper is a full and complete response to the Office action of 6, 2005. Applicant therefore respectfully requests that the Examiner reconsider his rejections and issue a Notice of Allowance in this case.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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